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Attorney Docket No.: 25447-A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
Eldad TAUB et al.

Serial No.: 10/752,410

Group Art Unit: 3732

Filed: January 7, 2004

Examiner: John J. WILSON

For: **PLACING AN ORTHODONTIC ELEMENT ON A TOOTH SURFACE**

TRANSMITTAL LETTER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:


Submitted herewith for filing in the U.S. Patent and Trademark Office is the following:

- (1) Transmittal Letter;
- (2) Response to Restriction Requirement.

Respectfully submitted,

**NATH & ASSOCIATES PLLC**

By:

  
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Registration No. 47,421  
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Date: July 9, 2004  
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MCB/JNR:RestrictionRequirement.TRANS



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**RESPONSE TO ELECTION/RESTRICTION REQUIREMENT**

Assistant Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action dated June 29, 2004. The one month shortened statutory period for response is set to expire on July 29, 2004, thus this response is timely filed.

**SUMMARY OF RESTRICTION REQUIREMENT**

Invention Groups. The Examiner has required restriction of claims 18-37 to a single invention under 35 U.S.C. 121. As the basis for this restriction requirement, the Official Action states the following:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 18-33 drawn to a method and system for positioning an orthodontic element, classified in class 433, subclass 24.
- II. Claims 34 and 35, drawn to a positioning device for

positioning an element on the surface of a tooth,  
classified in class 433, subclass 3.  
III. Claims 36 and 37, drawn to a marking device,  
classified in class 433, subclass 4.

The inventions are distinct, each from the other because of  
the following reasons:

Inventions I and II are related as process and apparatus for  
its practice. The inventions are distinct if it can be shown  
that either: (1) the process as claimed can be practiced by  
another materially different apparatus or by hand, or (2) the  
apparatus as claimed can be used to practice another and  
materially different process. (MPEP § 806.05(e)). In this  
case The method and system of Group I does not require the  
gripping member of Group II.

Inventions I and III are related as process and apparatus for  
its practice. The inventions are distinct if it can be shown  
that either: (1) the process as claimed can be practiced by  
another materially different apparatus or by hand, or (2) the  
apparatus as claimed can be used to practice another and  
materially different process. (MPEP § 806.05(e)). In this  
case the method and system of Group I does not require the  
marking member of Group III.

Inventions II and III are related as subcombinations  
disclosed as usable together in a single combination. The  
subcombinations are distinct from each other if they are shown  
to be separately usable. In the instant case, the invention  
of Group II has separate utility such as placing brackets  
without the use of a marking member. See MPEP § 806.05(d).

#### **PROVISIONAL ELECTION**

Applicants provisionally elect Group I (claims 18 - 33) drawn  
to a method and system for positioning an orthodontic element.

#### **TRAVERSAL**

Applicants respectfully traverse the Examiner's restriction  
requirement.

First, the restriction requirement is traversed because the

Examiner has not met the burden of showing that the apparatus as claimed can be used to practice another and materially different process; that the process as claimed can be practiced by another materially different apparatus; and that the subcombinations are distinct from each other. Further, applicants respectfully contend that the restriction between subcombinations (i.e. claims 34-37) is unreasonable.

Additionally, the restriction requirement is traversed because it omits "an appropriate explanation" as to the existence of a "serious burden" if a restriction were not required. See MPEP 803. Regardless of any differences that may exist between the inventions set forth in the claims of Groups I, II and III, a complete and thorough search for the invention set forth in any one of the Groups would require searching the art areas appropriate to the other Groups. Since a search of each of the Groups, as segregated by the Examiner would be coextensive, it would not be a serious burden upon the Examiner to examine all of the claims in this application.

Further at the Examiner's disposal are powerful electronic search engines providing the Examiner with the ability to quickly and easily search all of the claims. Considering that the Examiner will most likely undertake a search for the method and system of

claims 18 - 33, searching for the apparatus of other independent claims would be minimally burdensome on the Examiner.

Moreover, the fact that various claims may fall under different U.S. Patent and Trademark Office classes does not necessarily make them independent or distinct inventions. The classification system at the U.S. Patent and Trademark Office is based in part upon administrative concerns and is not necessarily indicative of separate inventive subject matter in all cases. However, the Examiner has acknowledged that each of the Groups are classified in class 433, so it would seem reasonable to expect that the Examiner could easily examine all of the claims in this application without imposing a serious burden upon the Examiner.

Furthermore, applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring applicants to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing applicants to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

In view of the foregoing, applicants respectfully request the

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Examiner to reconsider and withdraw the restriction requirement,  
and to examine all of the claims pending in this application.

If the Examiner has any questions or comments regarding this  
matter, he is welcomed to contact the undersigned attorney at the  
below-listed number and address.

Respectfully submitted,

**NATH & ASSOCIATES PLLC**

Date: July 9, 2004

By:



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